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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,039	10/15/2001	Edward J. Kuebert	08049.0831	1583
22852	7590	01/22/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JABR, FADEY S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 01/22/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,039

Applicant(s)

KUEBERT ET AL.

Examiner

FADEY S. JABR

Art Unit

3628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

Claim **20** has been cancelled. Claims **1, 3, 6, 11-15** and **30** have been amended. Claims **32** and **33** have been non-elected by restriction by original presentation. Claims **1-19** and **21-31** remain pending and are again presented for examination.

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims **1-19, 20-30** and **31**, drawn to a method and system of notifying a recipient that an item is en route, while also notifying a sender based on an identifier of a sender, while also accepting an instruction designating a second delivery point by a party, classified in class 705, subclass 1.
 - II. Claim **32**, drawn to a method of providing the information to a delivery service provider when a batch of items that includes the item are shipped, classified in class 705, subclass 1.
 - III. Claim **33**, drawn to a method for notifying a recipient that the item is en route by sending an image of the item, classified in class 705, subclass 1.

Newly amended claim **32-33**, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the

subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require providing information to a service provider of a batch of items, nor require an image of an item. Further, invention II does not require providing an image of the item to the service provider when notifying. The subcombination has separate utility such as providing information to a recipient or sender.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is respectfully requested to cancel the non-elected claims in response to this office action.

Response to Arguments

1. Applicant's arguments with respect to claims **1-19** and **21-30** have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant argues that none of the cited references disclose confirming the instruction to delivery the item to the second delivery point by notifying a sender of the second delivery point. However, Examiner notes Franco teaches selecting the item to be returned...assuming the item is returnable, display a page with a return authorization containing a return authorization number. If needed, the consumer has the option of printing the return authorization that preferably includes any applicable return instructions. Upon approval of the return, as evidenced by the return authorization number, the consumer simply drops the item to be returned (C. 4, line 52 -

C. 5, line 6). However, Franco teaches notifying a sender through shipping documents including bar-coded address labels (C. 62, line 65 - 63, line 7). Thus, Franco teaches confirming/approving an instruction to deliver the item to a second delivery point. Further, Franco teaches notifying a sender through shipping documents including bar-coded address labels, thus based on the unique identifier.

3. Applicant argues the cited references fail to disclose *conditionally accepting*. However, Barta teaches providing delivery notices to recipients of packages where an alternate address for the package can be provided given that the recipient is authenticated using the delivery notice information (C. 6, line 67 – C. 7, line 38). Thus, Barta teaches authenticating the recipient before accepting the alternate address.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-2, 5, 11-12** and **31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al., U.S. Patent No. 5,831,860 in view of Franco, U.S. Patent No. 7,257,552 B1, hereinafter referred to as Foladare and Franco.

As per **Claim 1-2 and 11**, Foladare discloses a method and system comprising:

- determining a first delivery point of the item (C. 3, lines 26-43; C. 5, lines 3-23);

- notifying, based on the first delivery point, a recipient that the item is en route (C. 3, lines 26-43; C. 5, lines 3-23);
- accepting at least one instruction designating a second delivery point (C. 3, lines 26-43; C. 5, lines 3-23); and
- delivering the item to the second delivery point (C. 3, lines 26-43; C. 5, lines 3-23).

Foladare fails to disclose notifying, based on an identifier of a sender, the sender that the item is en route. However, Franco teaches notifying a sender through shipping documents including bar-coded address labels (C. 62, line 65 - 63, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include notifying a sender based on shipping documents as taught by Franco in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 5, 12 and 31**, Foladare discloses a method and system comprising:

- determining a first delivery point of the item (C. 3, lines 26-43; C. 5, lines 3-23);
- notifying a recipient that the item is en route (C. 3, lines 26-43; C. 5, lines 3-23);
- receiving, from the recipient, an instruction specifying that the item is to be delivered to a second delivery point (C. 3, lines 26-43; C. 5, lines 3-23);
- delivering the item to the second delivery point (C. 3, lines 26-43; C. 5, lines 3-23).

Foladare fails to *explicitly* disclose confirming the instruction to deliver the item to the second delivery point by notifying a sender of the second delivery point; accepting the second delivery point from the sender. Foladare discloses notifying recipients and allowing recipients to choose to redirect packages (C. 3, lines 26-43; C. 5, lines 3-23). Moreover, Franco teaches selecting the item to be returned...assuming the item is returnable, display a page with a return authorization containing a return authorization number. If needed, the consumer has the option of printing the return authorization that preferably includes any applicable return instructions. Upon approval of the return, as evidenced by the return authorization number, the consumer simply drops the item to be returned (C. 4, line 52 - C. 5, line 6). However, Franco teaches notifying a sender though shipping documents including bar-coded address labels (C. 62, line 65 - 63, line 7).

The secondary reference shows that the need for notifying senders and allowing senders to approve the item to be redirected to another address was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing a sender to approve the return of a package as taught by Franco in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco as applied to claim 1 above, and further in view of Roberts et al., U.S. Patent No. 6,401,078 B1, hereinafter referred to as Roberts.

As per **Claim 3**, Foladare fails to *explicitly* disclose allowing the *sender* to specify that the item is to be delivered to the second delivery point. Foladare discloses notifying recipients and allowing recipients to choose to redirect packages (C. 3, lines 26-43; C. 5, lines 3-23). Moreover, Roberts teaches redirection of the vehicle and/or portions of the load en route may be desirable to respond to customers (shippers) needs or other factors (C. 13, lines 27-30).

The secondary references show that the need for notifying senders and allowing senders to specify the item to be redirected to another address was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing a sender to redirect a package as taught by Roberts in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

4. Claims **6-10** and **13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco, Roberts and Lopez, Pub. No. US2002/0029202 A1, hereinafter referred to as Lopez.

As per **Claims 6-7 and 13**, Foladare discloses a method and system comprising:

- determining a first delivery point of an item (C. 3, lines 26-43; C. 5, lines 3-23);

Foladare fails to disclose notifying a sender of an item that the item is undeliverable; accepting a disposition instruction from the sender, after the notifying; changing a delivery point of the item while the item is en route after accepting the disposition instruction; and handling the item according to the disposition instruction. However, Foladare discloses an addressee changing the location before delivery, the package carrier is informed, so as to be able to reroute the package (C. 3, lines 26-43; C. 5, lines 3-23). Moreover, Franco teaches notifying a sender though shipping documents including bar-coded address labels (C. 62, line 65 - 63, line 7). Further, Lopez teaches some mailpieces that cannot be delivered, will not be worth the cost of return postage, but senders nonetheless will want notification of the non-delivery (0009). Lopez teaches notifying the sender that the mailpiece has been forwarded (0013). Further, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040). Furthermore, Roberts teaches redirection of the vehicle and/or portions of the load en route may be desirable to respond to customers (shippers) needs or other factors (C. 13, lines 27-30).

The secondary references show that the need for notifying senders and allowing senders to specify the item to be redirected to another address was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include notifying a sender when an item is undeliverable and allowing a sender to redirect a package as taught by Franco, Lopez and Roberts in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claims 8-10, Foladare fails to disclose disposition instructions are to auction, donate or dispose of the item. However, Lopez discloses instructions for when the mailpiece is undeliverable, i.e. forwarding the mailpiece or returning the mailpiece to the sender (0035).

The secondary reference show that the need for receiving instructions from a sender when an item is undeliverable was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing a sender to redirect a package as taught by Lopez in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco as applied to claim 1 above, and further in view of Lopez.

As per Claim 4, Foladare fails to *explicitly* disclose notifying the *sender*, if actual delivery is made; and requesting disposition instructions from the sender, if delivery was not made. However, Franco notifying the sender upon receipt of the parcel by the recipient (C. 63, lines 1-7). Further, Lopez teaches notifying the sender that the mailpiece has been forwarded

(0013). Moreover, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040).

The secondary references show that the need for notifying senders and allowing senders to specify the item to be redirected to another address when the item is undeliverable was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include notifying a sender when an item is undeliverable and allowing a sender to indicate what to do with a mailpiece as taught by Franco and Lopez in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. Claims **14-15, 19, 28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco and Barta et al., U.S. Patent No. 6,634,551 B2, hereinafter referred to as Barta.

As per **Claims 14-15, 19, 28 and 30**, Foladare discloses a method and system comprising:

- determining a first delivery point of the item (C. 3, lines 26-43; C. 5, lines 3-23);
- providing a notification to indicate that the item is en route to the first delivery point (C. 3, lines 26-43; C. 5, lines 3-23);
- accepting a second delivery point of the item (C. 3, lines 26-43; C. 5, lines 3-23); and

- delivering the item to the first delivery point and second delivery point based on the acceptance of the second delivery point (C. 3, lines 26-43; C. 5, lines 3-23).

Foladare fails to *explicitly* disclose *conditionally* accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point.

Moreover, Franco teaches selecting the item to be returned...assuming the item is returnable, display a page with a return authorization containing a return authorization number. If needed, the consumer has the option of printing the return authorization that preferably includes any applicable return instructions. Upon approval of the return, as evidenced by the return authorization number, the consumer simply drops the item to be returned (C. 4, line 52 - C. 5, line 6). However, Franco teaches notifying a sender through shipping documents including bar-coded address labels (C. 62, line 65 - 63, line 7). Also, Franco teaches notifying the sender upon receipt of the parcel (C. 63, lines 1-7). Moreover, Barta teaches providing delivery notices to recipients of packages where an alternate address for the package can be provided given that the recipient is authenticated using the delivery notice information (C. 6, line 67 - C. 7, line 38).

The secondary references shows that the need for authenticating a user was known in the prior art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing a sender to approve the return of a package and authenticating a user as taught by Franco and Barta in the system of Foladare, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. Claim **16-18** and **29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco and Barta as applied to claim 14 above, and further in view of Lopez.

As per **Claim 16-18**, Foladare fails to *explicitly* disclose providing information to indicate that the item was not delivered, when the first delivery point and second delivery point are undeliverable. Foladare discloses a system which contacts the addressee and asks if the package should be redirected, and, if so, what should be the new address (C. 3, lines 31-40). Furthermore, Franco teaches notifying the sender upon receipt of the parcel (C. 63, lines 1-7).

Moreover, Lopez teaches notifying the sender that the mailpiece has been forwarded (0013). Further, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040).

The references show that the need for notifying senders and allowing senders to specify the item to be redirected to another address when the item is undeliverable was known in the prior art at the time of the invention.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of the shipping system of the secondary references for the shipping system of Foladare reference. Thus, the simple substitution of one known element for another producing a predictable results renders the claim obvious.

As per **Claim 29**, Foladare fails to disclose requesting, from the sender, an approval of the second delivery point. However, Lopez teaches a return-to-sender determiner responsive to the sender return address indicator (0040). Further, Franco teaches selecting the item to be returned...assuming the item is returnable, display a page with a return authorization containing a return authorization number. If needed, the consumer has the option of printing the return authorization that preferably includes any applicable return instructions. Upon approval of the return, as evidenced by the return authorization number, the consumer simply drops the item to be returned (C. 4, line 52 - C. 5, line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Foladare and include returning the mailpiece to the sender when the sender indicates return-to-sender service as taught by Lopez and Franco, because it allows the sender to be notified of the current status of the recipient's address when sending future mailpieces.

8. Claims **21-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco and Barta as applied to claim 14 above, and further in view of Kadaba, U.S. Patent No. 6,539,360 B1, hereinafter referred to as Kadaba.

As per **Claims 21-25**, Foladare fails to disclose characteristics of the item comprises determining a size of the item. Moreover, Kadaba teaches a package level detail notification transmitted to the carrier, or consignor or consignee which includes tracking number, item description, package weight, rate codes, special handling requirements and other pertinent

information (C. 7, lines 3-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Foladare and include determining various common package characteristics and transmitting them as taught by Kadaba, because it allows the system to provide the recipient with various common characteristics.

9. Claims **26-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Franco and Barta as applied to claim 14 above, and further in view of Jones, Pub. No. US2003/0233190 A1, hereinafter referred to as Jones.

As per **Claims 26-27**, Foladare fails to disclose wherein providing the notification to indicate the item is en route to the first delivery point comprises providing information to indicate a time the item will arrive at the first delivery point. However, Jones teaches informing a user when the delivery vehicle is a particular time away from their residence, and also allowing the recipient to enter the amount of time to be notified of the package delivery (0008, 0095). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Foladare and include informing the recipient of the time the mailpiece will arrive as taught by Jones, because it allows a recipient to adjust his/her schedule and avoid arrive too early or too late.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

Art Unit: 3628

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/F. S. J./

Examiner, Art Unit 3628

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628